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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,548	10/31/2003	Michael F. Hoey	M190.133.102	3065

7590 04/24/2006

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EXAMINER

PEFFLEY, MICHAEL F

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 04/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/699,548

Applicant(s)

HOEY ET AL.

Examiner

Michael Peffley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2113106
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 3, 2006 has been entered.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

Claims 6-16, 19-32, 35-45 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson et al (5,383,874) in view of the teaching of Osadchy et al (6,266,551).

Jackson et al disclose a surgical system comprising a surgical instrument (22) having an ablation element (16), a memory chip on the instrument and a processor for receiving the information stored on the chip (see columns 7 and 8). The processor is adapted to limit the number of times the device may be used (Abstract and col. 8, lines 59+) and is adapted to relate the delivery of appropriate energy based on the stored parameter (columns 7 and 8). The catheter may include a temperature sensor and store information regarding the temperature sensor (col. 7, lines 20-25). The method of operating such a device is fully disclosed by Jackson et al. Jackson et al do not

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specifically disclose that time limit information is used as an operating parameter stored on the memory chip.

Osadchy et al disclose another catheter device that includes a memory chip for storing calibration and usage information related to the catheter. In particular, Osadchy et al teach that the memory may be used to store the number of times the device has been used, just as in the Jackson et al system. Additionally, Osadchy et al teach that the time duration the device is used may be stored and preset such that the device is inoperable after being used for a predetermined time period. See, for example, column 6, lines 45-65 and column 8, lines 12-20. The examiner maintains that storing any desired time profile as it relates to the delivery of energy or the use of the device would be within the purview of the skilled artisan.

To have provided the Jackson et al device with programmed time duration information on the memory chip to monitor, control and limit the amount of time the catheter may be used would have been an obvious modification for one of ordinary skill in the art in view of the teaching of Osadchy et al.

Claims 17, 18, 33, 34, 46 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson et al (5,383,874) and Osadchy et al (6,266,551) and further in view of the teaching of Nardella (5,334,193).

The Jackson et al system, as modified by the teaching of Osadchy et al, has been previously addressed. While Jackson et al disclose that various catheters may be

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connected to the system, there is no specific mention of providing a source of fluid through the catheter and/or storing information regarding fluid flow.

The examiner maintains that one of ordinary skill in the art would recognize that any well-known catheter may be used with the Jackson et al system, including a fluid delivery catheter such as taught by Nardella. The Nardella catheter is very much like the ablative catheter disclosed by Jackson et al, and specifically includes means to provide a conductive fluid through the catheter as well as means to control the flow of the fluid. To have stored information regarding the fluid-flow parameters of such a catheter, or any other relevant information, would have been an obvious consideration for one of ordinary skill in the art.

To have provided the Jackson et al system, as modified by the teaching of Osadchy et al, with a fluid-delivery ablation catheter to enhance treatment of tissue in the presence of fluid would have been an obvious modification for one of ordinary skill in the art, particularly since Nardella teach of the advantages of providing conductive fluid to tissue during RF ablation procedures.

Response to Arguments

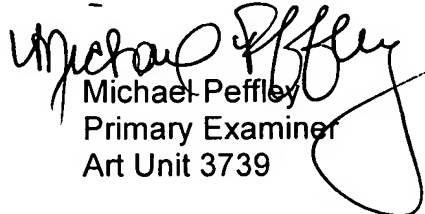
Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 6am-3pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Michael Peffley
Primary Examiner
Art Unit 3739

mp
April 10, 2006